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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,671	06/20/2001	Pamela M. Moss	50P4391	6367

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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,671

Applicant(s)

MOSS, PAMELA M.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1> Applicant's amendment and remarks have been received. Claims 5 and 21-24 have been cancelled. Claims 1-4 and 6-20 are presented for further examination.

Response to Arguments

2> Applicant's arguments with respect to claims 1-4 and 6-20 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment that altered the scope of the claims.

Claim Rejections - 35 USC § 102

3> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4> Claims 1-4, 6-8 and 11-20 are rejected under 35 U.S.C § 102(e) as being anticipated by Malik, U.S Patent Publication No. 2002/0065892 A1.

5> As to claim 1, Malik discloses a method for distributing media files over a computer network, comprising:

receiving at a server an electronic message that includes one or more recipients designated to receive said electronic message along with a specified media file [0011, 0021];
identifying the specified media file [0011, 0022];

searching a library of frequently transmitted media files to determine whether the specified media file exists in the library [0022, 0025]; and

if the specified media file exists in the library, transmitting a copy of the specified media file to said one or more recipients or, if the specified media file does not exist in the library, uploading the specified media file from an appropriate drive to a predetermined server and transmitting to said one or more recipients a copy of the specified media file from the predetermined server [0027, 0028, 0029, 0040 where: as is known in the art, the email with attachment is transmitted to the recipients' email address and stored on the email server where the attachment is downloaded with the email by the recipient when he checks his mail].

6> As to claim 2, Malik discloses the method according to claim 1, wherein the specified media file comprises an audio file [0032].

7> As to claim 3, Malik discloses the method according to claim 1, wherein the specified media file comprises a video file [0032].

8> As to claim 4, Malik discloses the method according to claim 1, wherein the specified media file comprises a multimedia file [0032].

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9> As to claim 6, Malik discloses a method for distributing media files over a computer network, comprising:

receiving at a server an electronic message that includes one or more recipients designated to receive said electronic message along with a specified media file [0011, 0021];

identifying the specified media file [0011, 0022];

searching a library of frequently transmitted media files to determine whether the specified media file exists in the library [0022, 0025]; and

if the specified media file exists in the library, transmitting a copy of the specified media file to said one or more recipients or, if the specified media file does not exist in the library, uploading the specified media file from an appropriate drive to a predetermined server and transmitting to said one or more recipients a copy of the specified media file from the predetermined server [0027, 0028, 0029, 0040 where: Malik discloses a process of downloading email, the process including retrieving the associated stored attachment file when the email is downloaded],

the method further comprising the step of detecting a size of the specified media file attached to the electronic message,

wherein the search of the library is performed only if the specified media file exceeds a predetermined size [0025, 0026].

10> As to claim 7, Malik discloses the method according to claim 1, further comprising logging a number of times a particular file is attached to an electronic message for transmission over the computer network [0022 where: Malik discloses storing files based on

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how many times it is referenced by emails. Therefore, logging a number of times a particular file is attached to an electronic message is implicit to Malik's cache].

11> As to claim 8, Malik discloses the method according to claim 7, further comprising storing in said library a list of media files, each of which has been transmitted by electronic message over the computer network more than a predetermined number of times along with an associated location in the computer network for each file [0022, 0024, 0028, 0029 where: Malik discloses caching attachment files when they are associated with more than one electronic message].

12> Claims 11-14 are claims to computer readable media that perform the steps of the method of claims 1-4 respectively. Therefore claims 11-14 are rejected for the same reasons as set forth for claims 1-4, supra.

13> As to claim 15, Malik discloses a system for transferring media files from a sender to multiple recipients, comprising:

a server associated with a first computer [0021]; and

an electronic messaging system adapted to operate over the server, said messaging system being adapted to generate electronic messages of a first type which have at least one media file attached thereto and which designate a plurality of recipients, said messaging system being further adapted, when an electronic message of said first type is sent from said first computer [0007, 0021, 0024, 0030, 0040], to

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identify the attached file [0011, 0022];

search a library of frequently transmitted files to determine whether the attached file exists in the library [0031], and

transmit, if the attached file exists in the library a copy to said one or more recipients, together with the electronic message, or, if the specified file does not exist in the library, upload the specified file from an appropriate drive to a predetermined server and transmit to said one or more recipients the specified file from the predetermined server together with the electronic message [0021, 0024, 0027, 0028, 0029, 0030, 0040].

14> As to claims 16-18, as they are merely claims to systems that implement the steps of the method of claims 2-4, respectively, they do not teach or further define over the claimed limitations. Therefore, claims 16-18 are rejected for the same reasons set forth for claims 2-4, *supra*.

15> As to claim 19, Malik discloses the system of claim 15, wherein the file is copied to a first recipient by copying the file from the first server to a second server associated with the first recipient [Figure 1 «items 12 and 16» | 0006].

16> As to claim 20, Malik discloses the system of claim 15 wherein the message is generated on a system and wherein the file is uploaded to the server from the system when the message is sent [0027].

Claim Rejections - 35 USC § 103

17> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18> Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Greenwood et al, U.S. Patent No. 5,568,181 ["Greenwood"].

19> As to claim 9, Malik does not explicitly disclose ranking a plurality of media files based on how often each media file has been transmitted over the computer network.

20> Greenwood discloses the method further comprising ranking a plurality of media files based on how often each media file has been transmitted over the computer network [column 3 <line 62> to column 4 <line 3> where: files are removed from the cache based on a ranking system (i.e. "little-used" files are removed first)]. It would have been obvious to one of ordinary skill in the art to incorporate Greenwood's ranking algorithms into Malik's caching system to enhance Malik's capability for removing lesser used files from the cache in order to make space if necessary.

21> As to claim 10, Malik does disclose storing in said library an identity of media files, along with a location in the computer of each said media files [Figure 5], but does not

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explicitly disclose ranking the media files or storing the identities of a predetermined number of said ranked media files.

22> Greenwood discloses ranked media files or storing the identities of a predetermined number of said ranked media files [column 3 <line 63> to column 4 <line 8>]. It would have been obvious to one of ordinary skill in the art to incorporate Greenwood's ranking algorithms into Malik's caching system to enhance Malik's capability for removing lesser used files from the cache in order to make space if necessary.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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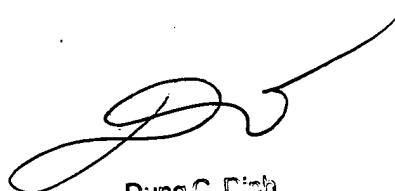
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is (571)272-3942.

The examiner can normally be reached on 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system; contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



Dung C. Dinh
Primary Examiner